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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,339	08/01/2003	Thomas Richards	08935-294001 / M-5029	4181
26161	7590	07/22/2008	EXAMINER	
FISH & RICHARDSON PC			ECHELMEYER, ALIX ELIZABETH	
P.O. BOX 1022				
MINNEAPOLIS, MN 55440-1022			ART UNIT	PAPER NUMBER
			1795	
			MAIL DATE	DELIVERY MODE
			07/22/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/633,339	RICHARDS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alix Elizabeth Echelmeyer	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 April 2008.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15,51-55 and 59-89 is/are pending in the application.  
 4a) Of the above claim(s) 14,71-82,86 and 88 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-13,15,51-55,59-70,83-85,87,89 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

**DETAILED ACTION*****Response to Amendment***

1. This Office Action is in response to the amendment filed April 28, 2008. Claims 8 and 9 have been amended. Claims 16-50 and 56-58 were previously cancelled. Claims 14, 71-82, 86 and 88 were previously withdrawn. Claims 1-13, 15, 51-55, 59-70, 83-85, 87 and 89 are rejected for the reasons given below.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8, 12, 15, 51-55, 59-68, 83-85, 87 and 89 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US Patent 6,955,187).

Regarding claims 1-3, 51-53 and 59-61, Johnson teaches a battery having a control valve for controlling airflow into the battery. The control portion is made of two cylindrical sleeves, or members, having holes, that can be moved into or out of registration depending on whether air is required for the cell. The movement is controlled by actuators that are attached to the cylinders (abstract; Figure 1; column 3 lines 9-11). Further, Johnson teaches that the current

required to induce a shape change in the actuators is generated by electricity from the electrochemical cell (column 4 lines 15-17).

As for claims 4, 15 and 62, as seen in Figure 1, the multiple holes are arranged in columns along the cylinders.

Regarding claims 5 and 63, it can be seen in Figures 5 and 6 that the second member is coupled to the mechanism and that the second member moves in relation to the first.

As for claims 83, 85 and 87, the “first member” of the instant application is considered the inner member of Johnson and the “second member” the outer member. Thus, Johnson also teaches these limitations as discussed above.

As for claims 6, 55, 64, 67, Johnson teaches that the actuators are made of wire shape memory alloys (column 3 lines 55-59).

Regarding claims 7, 65 and 89, Johnson further teaches that the shape memory alloy is preferably TiNi (column 3 lines 59-61).

As for claim 54, in Johnson, the current required to induce a shape change in the actuators is generated by electricity from the electrochemical cell (column 4 lines 15-17).

Regarding claims 12 and 68, it can be seen in Figures 5 and 6 of Johnson that a member is coupled between the actuator and the upper end portion of the second member.

Regarding claims 8, 66 and 84, Johnson teaches that when the valve is in the fully off position, no current flows from the cell to the wire actuator (column 5 lines 22-27).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13, 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson.

The teachings of Johnson as discussed above are incorporated herein.

Johnson discloses the claimed invention except for the shape memory alloy actuator being in the shape of a ribbon instead of a wire. It would have been an obvious matter of design choice to use a ribbon or a wire, since such a modification would have involved a mere change in the shape of the component. A change in shape is generally recognized as being within the level of ordinary skill in the art. MPEP 2144.04 (IV B).

6. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson as applied to claim 6 above, and further in view of Brotz (US 5,588,295).

The teachings of Johnson as discussed above are incorporated herein.

Regarding claim 10, it can be seen in Figures 5 and 6 of Johnson that a member is coupled between the actuator and the upper end portion of the second member.

Johnson fails to teach the mechanism of the instantly claimed invention, specifically, a member made of a shape memory alloy responsive to current which changes from concave to convex, which in turn moves the members in relation to one another.

In Figures 5 and 6 of Johnson, it is seen that two components go into a mechanism that moves the two members in relation to one another. The first, an actuator mechanism (29), contains a shape memory alloy (column 3 lines 55-67). The second is a latch mechanism (94) that changes from concave to convex in shape, depending on how the members are situated relative to one another.

Brotz teaches a memory metal actuator that may be concave or convex in shape depending on the current applied to it (abstract, Figures 3 and 4).

The mechanism of Brotz is further taught to be in a neutral, or straight position when no current is applied (abstract). One of ordinary skill in the art could easily conceive of arranging the latch mechanism of Johnson such that the “first position”, or closed position, occurred when no current was being drawn from the battery, since the air holes would be closed and the battery would not be generating current.

It would be desirable to replace the latch and actuator mechanism of Johnson with the actuator of Brotz since the actuator of Brotz would solve the same problem of Johnson, to open or close the members in relation to each other, since it would eliminate the need for both the latch and the actuator mechanism of Johnson, making production of the cell simpler since fewer parts would be needed.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the latch and actuator mechanism of Johnson with the actuator of Brotz, making production of the cell simpler since fewer parts would be needed.

***Response to Arguments***

7. Applicant's arguments, see Remarks, filed April 28, 2008, with respect to the rejection of claim 10 under Johnson have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made over Johnson in view Brotz, see above.

8. Applicant's arguments filed April 28, 2008 have been fully considered but they are not persuasive, except for the argument concerning claim 10 as discussed above.

First, Applicant argues that claims 1-8, 12, 15, 51-55, 59-68, 83-85, 87 and 89 are not anticipated by Johnson. Specifically, regarding claim 1, Applicant argues that Johnson discloses two actuators. The examiner agrees, but the claim requires a "member." In this case, the actuator mechanism of Johnson, having two actuators and a rod attaching the actuators to the first and second members, is considered a member whose shape deforms in the context of the instant claims.

Claim 8 has been addressed in the rejection. Johnson teaches that no current flows to the actuator when the valve is off, as in not changing state.

As for claim 51, as discussed above, the actuator mechanism of Johnson, having two actuators and a rod attaching the actuators to the first and second members, is considered the member whose shape deforms in the context of the instant claims.

Regarding the 103 rejection over Johnson, Applicant argues that the arrangement of Johnson requires two separate mechanisms. Yet, the actuator mechanism of Johnson, having two actuators and a rod attaching the actuators to the first and second members, is considered a member whose shape deforms in the context of the instant claims.

Applicant argues that the rejection of Johnson in view of Brotz employs hindsight reasoning. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alix Elizabeth Echelmeyer whose telephone

number is (571)272-1101. The examiner can normally be reached on Mon-Fri 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susy N. Tsang-Foster can be reached on 571-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alix Elizabeth Echelmeyer  
Examiner  
Art Unit 1795

aee

/Susy Tsang-Foster/

Supervisory Patent Examiner, Art Unit 1795